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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/539,941 | 06/17/2005 | Harald Wolf | 3926.177 | 1142 |

30448 7590 04/13/2007
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| EXAMINER |
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ADAMS, GREGORY W

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| ART UNIT | PAPER NUMBER |
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3652

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/13/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/539,941 | Applicant(s) WOLF, HARALD | |
| | Examiner Gregory W. Adams | Art Unit 3652 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the phrase "and/or" in line 8 renders the claim indefinite because a limitation can be optional or required but cannot be both. See MPEP § 2173.05(d). For purposes of examination, the limitation following "and/or" will be treated as optional. See also claim 7, line 13.

With respect to claim 2, line 3 is unclear. Claim 1 recites carrier units 16, whereas claim 2 recites "the carrier unit" in line 3. It would be better to recite --a respective one of said carrier units--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 & 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Leuthold et al. (US 5,803,446).

With respect to claim 1, Leuthold et al. disclose a method for transporting bodywork panels comprising:

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- adjusting intervals between carrier units in a transport direction (FIGS. 4A-4F),
- stacking an associated group of panels 1, 2 on at least one carrier unit 20, 40;
- transporting a group of panels as far as a panel removal station (indicated generally as 30); and
- in each case removing an individual bodywork panel by a panel separation device 31.

With respect to claim 2, Leuthold et al. disclose bodywork panels of a respective group of panels are stacked and supported at their edges by a carrier unit at a panel group formation station.

With respect to claim 3, Leuthold et al. disclose a group of panels in a carrier unit 20, 40 is built up by means of the successive deposition of individual bodywork panels.

With respect to claim 4, Leuthold et al. disclose individual bodywork panels 1, 2 are deposited in the carrier unit manually or in an automated manner, forming the group of panels. Applicant is respectfully reminded that it was known at the time of the invention that merely providing an automated way to replace a well-known activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). And, it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. *In re Venner*, 120 USPQ 192.

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With respect to claim 5, Leuthold et al. disclose a group of panels transported from a panel group formation station as far as the panel removal station in a transport direction that extends obliquely upward.

With respect to claim 6, Leuthold et al. disclose a respective group of panels that is transported by means of the transport device during a predefinable cycle time, the cycle time depending on the required panel separation time of a complete group of panels respectively located at the panel removal station.

With respect to claim 7, Leuthold et al. disclose a transport device:

- an associated group of panels 1,2 can be stacked on at least one carrier unit 20, 40;
- a group of panels 1, 2 can be transported as far as a panel removal station 30;
- in each case an individual bodywork panel can be removed by a panel separation device 30 at the panel removal station, wherein the transport device is an inclined (C4/L43) transport device;
- wherein the intervals between the carrier units in the transport direction and/or the distance between the carrier elements in the direction transverse to the transport direction are adjustable the transport device

The expression “an individual bodywork panel can be removed by a panel separation device at the panel removal station” is functional by nature such that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being

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used, as claimed. See MPEP 2112.02, 2114. Here, Leuthold's apparatus is certainly capable of removing a panel by a panel separation device 31.

With respect to claim 10, Leuthold et al. disclose a number and/or design construction of carrier elements 21, 41 used in a carrier unit can be varied as a function of the geometric shape of a bodywork panel.

With respect to claim 12, Leuthold et al. disclose an inclined transport device with an adjustable transport direction.

With respect to claim 13, Leuthold et al. disclose as a panel removal pivoting gripper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leuthold et al. (US 5,803,446) in view of Lawson (US 3,162,292). Leuthold et al. does not explicitly disclose a transport device that moves carrier elements 21, 41 along a transport path but does disclose movement along a transport path. Leuthold et al. does not disclose a chain transport device. It is noted that the Examiner assumes the chain transport device moves the carrier elements but notes that no limitation appears in claim 11. Lawson discloses a chain transport device 30 which moves carrier elements 32 along a transport path which transfers and unscrambles boards from a larger stack of

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lumber items. C3. Thus, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Leuthold et al. to include a chain transport device, as taught by Lawson, to separate lumber from a stack.

Response to Arguments

Applicant's arguments filed March 29, 2007 have been fully considered but they are not persuasive.

With respect to claim 1, as noted above, "and/or" is unclear as to whether the succeeding limitation is required or optional. For examination purposes, the cited prior art discloses carrier units that are variable in a transport direction as shown in Leuthold's FIGS. 4a-f. The Examiner appreciates Applicant's explanation of the benefits of adjustability both in a transport direction and a direction transverse to a transport direction but evidence of secondary considerations should be submitted in an evidentiary affidavit and is proper in a 103 obviousness type rejection.

With respect to claims 7 & 11, in response to applicant's argument that the cited prior art does not disclose adjustability, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Leuthold's supporting elements are certainly adjustable in at least a transport direction as FIGS. 4a-f disclose the supports 20, 40 spaced at unique relative locations.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

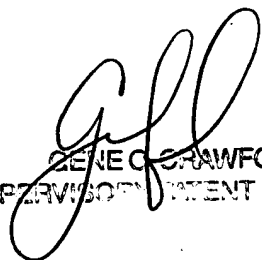
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W. Adams whose telephone number is (571) 272-8101. The examiner can normally be reached on M-Th, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GWA


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